

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-2, 4-9, 11-13, 15-17, 19 and 21-27 have been rejected.

Claims 3, 10, 14, 18 and 20 were previously canceled.

Claims 4, 9, 21 and 23-26 have been canceled, without prejudice.

Claims 1-2, 13, 22 and 27 have been amended.

Claims 1-2, 5-8, 11-13, 15-17, 19, 22 and 27 are pending in this application.

Claims 1-2, 4-9, 11-13, 15-17, 19 and 21-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (U.S. Patent No. 6,183,366 hereinafter Goldberg) in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). This rejection is respectfully traversed.

Independent claim 1 (13 and 27) have been amended to include that advertisements are limited to a predetermined number (quota) during a predetermined time period. Support for this can be found in the specification on page 19, line 23, page 21, line 14 and page 28, lines 17-18. Claims 1 and 27 have also been amended to recite that the method determines whether an advertisement was delivered to a user. Support for this can be found on page 22, line 10. Claims 1, 13 and 27 have also been amended to recite that advertisements are delivered depending on a future location of the subscriber. Support for this can be found on page 29, line 27 and page 27, lines 24-26. Claims 1, 13 and 27 have also been amended to recite that advertisements are terminated upon reaching the quota. Support for this can be found on page 22, line 4 and lines 11-12.

Applicants respectfully submit that the independent claims, as amended, are sufficiently distinct and non-obvious from the prior art without requiring a further continuation of this application.

Goldberg describes a method and apparatus for automating the playing of games to users on the Internet (col. 1, lines 17-20). There is an embodiment that describes enhanced features for presenting sponsor or advertiser information that match player profiles over the Internet (col. 21, lines 58-63; Col. 29, lines 7-20) in return for cost savings on Internet access. However, Goldberg does not teach quotas for advertising. Inasmuch as Goldberg does not teach quotas, Goldberg could not envision the termination of advertising upon reaching the quota. Further,

Goldberg does not teach the determination that advertisements have been delivered. Nor does Goldberg teach the delivery of advertisements based upon a future location of a wireless communication device. There is no suggestion that Goldberg would have this location feature since that system does not disclose any type of location or direction finding sensors for mobile devices, but is rather simply drawn towards a fixed terminal hardwired into the Internet to receive advertisements.

Therefore, with regard to independent claims 1, 13 and 27, Goldberg does not teach or suggest: that advertisements are based upon a future location of the wireless communication device, that advertisements have quotas, determining whether advertisements were received, and the terminating advertisements upon reaching a quota.

Further, with regard to independent claim 13, Goldberg does not teach or suggest the step of requiring user interaction to determine whether an advertisement was reviewed and considered an advertisement that was provided in lieu of receiving compensation for the service. In contrast, Goldberg is distinguishable because it discusses only making sure a view add feature is running, but does not discuss at all any two way interaction. The inclusion of feedback is a significant addition to the claimed system.

Titmuss describes a method of delivering information, based on content, to mobile users in a telecommunication system. Also, Titmuss does discuss the transfer of information based on an existing location of a terminal. Titmuss does not discuss "speed" or "direction" which might be used to predict future locations, as implied by the Examiner. Instead, Titmuss is solely concerned about past or present static locations. Titmuss, however, does not make up the deficiencies in Goldberg. For example, with regard to claim 1, Titmuss does not teach or suggest at least the providing of advertisements based upon a future location of the wireless communication device. In addition, Titmuss is silent as to advertisements and how they could be provided to an end user in relation to compensation for subscription fees. Therefore, Titmuss could not envision the use of quotas, whether an ad has been received by a subscriber, and the termination of advertisements upon reaching a quota. With regard to claim 13, Titmuss does not teach or suggest at least the step of requiring user interaction to determine whether an advertisement was reviewed and considered an advertisement that was provided in lieu of receiving compensation for the service. Titmuss appears to be related to a much more complex

system where a user has access to many types of terminals and the ability of the user to select or access information from those terminals depending on the file type.

The future locating capabilities of applicants invention provides an great advantage over the prior art, in that, a motorist or other mobile user would be much less likely to backtrack over their previous path to visit an advertiser than they would visit an advertiser that is ahead of them on their path. This prevents wasted advertising and better targets users. Moreover, the use of quotas would be much more likely to lure users to a service, in that, a user would be much likely to subscribe to a service if they knew they would not be subject to an endless barrage of advertising, but instead be subject to a fair portion of advertising in exchange for their patronage.

In view of the above changes, applicants respectfully submit that claim 1 (13 and 27) should now be in a condition for allowance.

With regard to claim 2, claim 2 has been amended to recite temporal limitations to advertisements. Support for this can be found on page 24, line 19 and page 31, lines 17-18. Neither Goldberg nor Titmuss suggest or discuss temporal limitations in advertising.

With regards to claim 12, we are unsure of the Examiner's objection here since claim 12 recites advertising based upon sensors in a vehicle. Neither Goldberg nor Titmuss address sensors in vehicles, states of sensors, or basing advertising upon states of vehicle sensors. The only common element here is a communication network, which applicants respectfully submit is insufficient for an obviousness rejection.

With regard to claim 9, claim 9 has been canceled.

In further regard to claim 13, although Goldberg discusses interaction between Internet daemons and nodes to confirm their activity, this is completely different than requiring a user to interact with the system. Requiring user interaction demonstrates that the user is present when the advertisement is aired. With Goldberg's system a user can simply leave their computer on overnight and not even be there to look at an advertisement. Moreover, independent claim 13 has been amended to include recitations similar to claim 1, described above, which have been previously distinguished from both Goldberg and Titmuss.

In regards to claims 23, 24 and 4, these claims have been canceled.

In regards to claim 5, claim 5 is dependent on claim 1, and therefore includes all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

In regards to claim 6, neither Goldberg nor Titmuss require two-way communication with a user regarding an advertisement, wherein a user must accept an advertisement before the advertiser can send the message. Applicants respectfully submit that the Examiner's reference to coupons is completely different than an acceptance of an advertisement. In addition, claim 6 is dependent on claim 1, and therefore includes all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

In regards to claims 7, 8, 15 and 16, these claims involve a shopping list of an end user and a shopping history of an end user. Such list or history involve products or services of interest to an end user and derived therefrom. The Examiner cites page 14 paragraph 1 of Titmuss for the proposition that it teaches that "user preferences data" includes a shopping list of the user. However, Applicants are unable to find any reference to a shopping list in the explicitly supplied examples of user preference data. In addition, a shopping history is not suggested or disclosed in the user preferences. Instead, user preferences appear to indicate general preferences and can not be construed as an indication of specific products or services desired by an end user. Accordingly, it does not appear that Titmuss is appropriate to cite as prior art to these claims. Moreover, claims 7 and 8 are dependent on amended claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above. Claims 15 and 16 are dependent on amended claim 13, and therefore include all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

In regards to claim 11 and 19, although the art may disclose accessing customer information, the art does not suggest or disclose the storage of temporal information for a consumer. The cited references fail to provide this specific feature in the wireless communication network as taught and claimed in the present application. Deficiencies of the cited references (Goldberg or Titmuss) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art). Therefore, applicants respectfully submit that it would not have been obvious to time advertisements without any prior art that demonstrates this particular feature.

Claim 17 is dependent on claim 13, and therefore includes all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

In regards to claims 21, 22, 25 and 26, claims 21, 25 and 26 have been canceled. Claim 22 has been amended to reference future location as the determining factor for advertising. This has been previously discussed with respect to claim 13. Moreover, claim 22 is dependent on claim 13, and therefore includes all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

With regard to independent claim 27, the office action does not specifically address the added limitations in claim 27 but simply refers to the discussion relating to claims 12 and 13. Claim 27, however, recites that the step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references (Goldberg or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors. The applicant respectfully requests for identification of where this feature is located in the cited references.

Applicants respectfully submit that the prior art references, in combination or alone, fail to teach or suggest all of applicants' claimed limitations, as required for a 35 USC §103(a) rejection. Namely, with regard to claims 1, 13 and 27 (and its dependent claims), none of the references teach at least the steps of providing a quota of advertising, advertisements based upon future location, determining whether advertisements have been delivered, or terminating advertisements upon reaching a quota. With regard to claim 13, none of the references teaches at least the step of requiring user interaction to determine whether an advertisement was reviewed to be and considered an advertisement that was provided in lieu of receiving compensation for the service. Additionally, with respect to independent claim 27, none of the references teaches the additional step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device.

Therefore, the teachings of Goldberg and Titmuss, combined, fail to teach or even suggest the novel and unobvious recitations of the above claims. For the foregoing reasons, applicants believe that the claims, as amended, are patentably distinct and non-obvious from all of the references of record, whether taken alone or in combination.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.


No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection or through an Examiner's amendment.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

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